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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/812,508	03/07/1997	JANAK KHIMCHAND PADIA	5117-C1-41-P	2435

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EXAMINER

RAO, DEEPAK R

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 09/29/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
08/812,508

Applicant(s)
Padia

Examiner
Deepak Rao

Art Unit
1624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep 2, 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5, 6, 8, 9, 18-21, 25, 27-29, and 50-72 ☒ are pending in the application.
- 4a) Of the above, claim(s) 5, 6, 8, 51, 54, 55, and 57-61 ☒ are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9, 18-21, 25, 27-29, 50, 52, 53, 56, and 62-72 ☒ are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

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DETAILED ACTION

Claims 5-6, 8-9, 18-21, 25, 27-29 and 50-72 are pending in this application.

Election/Restriction

Applicant's election of Group I in Paper No. 16 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Note: Claim 25 was inadvertently left out in the previous office action. It is affirmed that the claim is pending and is examined as part of the elected invention.

Applicant's election of the species of Example 7 as depicted on page 50 is acknowledged. The species represents a compound of Formula I wherein:

W, X, Y, Z are C-R₃, C-R₄, C-R₅, CR₆ respectively;

R₃-R₆ are H;

M is O;

A is -NH-C(=O)-NH-; and

R₁ and R₂ are substituted phenyl.

The elected species reads on claims 50, 52-53, 56, 62, 9, 18-21, 25, 27-29 and 63-72.

Applicant is reminded of the election of species guidelines provided in MPEP § 803.02, which are followed for examination. Portion from MPEP is provided here for convenience:

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As an example, in the case of an application with a Markush-type claim drawn to the compound C-R, wherein R is a radical selected from the group consisting of A, B, C, D and E, the examiner may require a provisional election of a single species, CA, CB, CC, CD or CE. The Markush-type claim would then be examined fully with respect to the elected species and any species considered to be clearly unpatentable over the elected species. If on examination the elected species is found to be anticipated or rendered obvious by prior art, the Markush-type claim and claims to the elected species shall be rejected, and claims to the non-elected species would be held withdrawn from further consideration. As in the prevailing practice, a second action on the merits on the elected claims would be final.

On the other hand, should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended. If prior art is then found that anticipates or renders obvious the Markush-type claim with respect to a nonelected species, the Markush-type claim shall be rejected and claims to the nonelected species held withdrawn from further consideration. The prior art search, however, will not be extended unnecessarily to cover all nonelected species. Should applicant, in response to this rejection of the Markush-type claim, overcome the rejection, as by amending the Markush-type claim to exclude the species anticipated or rendered obvious by the prior art, the amended Markush-type claim will be reexamined. The prior art search will be extended to the extent necessary to determine patentability of the Markush-type claim. In the event prior art is found during the reexamination that anticipates or renders obvious the amended Markush-type claim, the claim will be rejected and the action made final. Amendments submitted after the final rejection further restricting the scope of the claim may be denied entry.

The elected species was not found in the prior art search and as per the guidelines above, the search was expanded to cover compounds of formula (I) wherein R_2 is polyaromatic and R_1 is unsubstituted phenyl or polyaromatic, while retaining the definitions of all other variables as indicated above for the elected species, and art was found. As per the guidelines above, claims 51, 54, 55, 57-61, 5, 6 and 8 drawn to compounds wherein the groups R_1 and R_2 are other than as indicated above are additionally withdrawn from consideration pursuant to 37 CFR 1.142(b), as being drawn to non elected inventions.

Claim Rejections - 35 U.S.C. § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 70 and 72 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for treatment, does not reasonably provide enablement for prevention. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

In evaluating the enablement question, several factors are to be considered. Note *In re Wands*, 8 USPQ2d 1400 and *Ex parte Forman*, 230 USPQ 546. The factors include: 1) The nature of the invention, 2) the state of the prior art, 3) the predictability or lack thereof in the art, 4) the amount of direction or guidance present, 5) the presence or absence of working examples, 6) the breadth of the claims, and 7) the quantity of experimentation needed.

The scope of the claims is not adequately enabled solely based on the activity related to CCK antagonistic activity provided in the specification.

The instant claim 70 recites 'treating or **preventing** panic' and therefore, the claim includes not only treatment but also "prevention" which is not remotely enabled. Based on the CCK antagonistic activity, the instant compounds are claimed to be useful in the "prevention" of 'panic' for which applicants provide no competent evidence. "To prevent" actually means *to anticipate or counter in advance, to keep from happening etc.* (as per Webster's II Dictionary) and therefore it is not understood how one skilled in the art can reasonably establish the basis and the

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type of subject to which the instant compounds can be administered in order to have the 'preventive' effect. It is inconceivable how the *in vitro/in vivo* activity of the representative compounds can be correlated to the '**prevention**' of the disorder, such that the claimed compounds can not only treat but also "prevent" the disease associated with the stated activity. Further, there is no evidence on record which demonstrates that the *in vitro/in vivo* screening test relied upon is recognized in the art as being reasonably predictive of success in any of the contemplated areas of '**prevention**'. Such a reasonable correlation is necessary to demonstrate such utilities. See *Ex parte Stevens*, 16 USPQ 2d 1379 (BPAI 1990); *Ex parte Busse et al.*, 1 USPQ 2d 1908 (BPAI 1986) (the evidence must be accepted as "showing" such utility, and not "warranting further study"). A recent state of the art reference, Liebowitz (PubMed Abstract enclosed) describes 'panic disorder as a chronic illness' and expresses the unpredictability in short-term therapeutic approaches. In the author's opinion, 'durable effects of individual treatments remain to be determined'. This is clearly indicative of the uncertainty of even the therapeutic approach of panic disorder and therefore, **preventing** the disorder would be even more challenging. Claim 72 is included here because it recites "an agent for treating or **preventing** panic" (see lines 10-11).

Thus, factors such as "sufficient working examples", "the level of skill in the art" and "predictability", etc. have been demonstrated to be sufficiently lacking in the use of the invention. In view of the breadth of the claim, the chemical nature of the invention, the unpredictability of ligand-receptor interactions in general, and the lack of working examples

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regarding the activity of the claimed compounds, one having ordinary skill in the art would have to undergo an undue amount of experimentation to use the invention commensurate in scope with the claim.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 50-72, 5-6, 8-9, 18-21, 25 and 27-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

1. In the claims, many of the "A" groups show inappropriate bonds to atoms, see e.g., claim 50, page 3, line 9, the second group wherein the =NCN is improperly attached to the N atom, which should have been on the C atom that is between the two N atoms. Also, some groups show a "0" (zero) to represent an oxygen "O", see e.g., claim 50, page 3, line 10, first two groups. Correction is required for all such defects through all the claims, particularly wherein the definitions of "A" group are present (Applicant's attention is particularly directed to all independent claims).
2. Claim 20 depends from claim 1 which has been canceled.
3. Claim 25 recites the limitation " R_2 is $-C(R_{15})(R_{16})-S(O)_f-NR_{13}R_{14}$ " in lines 1-2. There is insufficient antecedent basis for this limitation in claim 61 on which claim 25 is dependent. In claim 61, the above group is listed as a substituent of R_2 group.

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4. Claims 28-29 recite "R₁₇ is isopropyl", see line 6 of each of the claims. There is insufficient antecedent basis for this limitation in claim 62 on which the claims depend from. Claim 62 does not contain R₁₇ anywhere in the claim or structural formula.

Claim Rejections - 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 50, 54, 56, 62, 9, 18 and 27-29 rejected under 35 U.S.C. 102(b) as being anticipated by Kottke et al., Chem. Abstract 99:158378h (cited in IDS). The instant claims read on the compounds disclosed in the reference, see e.g., compound having RN 87466-06-6.
2. Claims 62 and 27-29 are rejected under 35 U.S.C. 102(b) as being anticipated by DD 225131 (cited in IDS). The instant claims read on the compounds disclosed in the reference, see e.g., RN 77747-37-6.

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3. Claims 62 and 27-29 are rejected under 35 U.S.C. 102(b) as being anticipated by DD 158549 (cited in IDS). The instant claims read on the compounds disclosed in the reference, see e.g., RN 77066-19-4.

Allowable Subject Matter

Claims 63-69 and 71 would be allowable if rewritten or amended, limiting to the examined subgenus as indicated above, and to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Claims 52, 19-21 and 25 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims, limiting the claims to the subgenus indicated above.

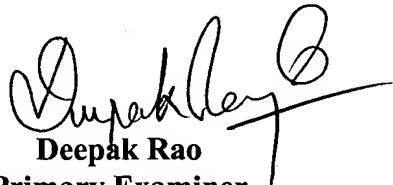
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deepak Rao whose telephone number is (703) 305-1879. The examiner can normally be reached on Tuesday-Friday from 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Mukund Shah, can be reached on (703) 308-4716. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.


Deepak Rao
Primary Examiner
Art Unit 1624

September 27, 2003